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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Rodrigo Munoz

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EXAMINER

KESACK, DANIEL

ART UNIT

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3691

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/886,912	Applicant(s) MUNOZ, RODRIGO	
	Examiner Daniel Kesack	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-20 is/are pending in the application.
- 4a) Of the above claim(s) 9-16 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8 and 17-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the amendment and arguments filed November 19, 2007. Applicant's amendments and remarks have been entered and fully considered. Claims 1-3, and 5-20 are currently pending, with claims 9-16 and 20 being withdrawn from further consideration. The rejections are as stated below.

Claim Rejections - 35 USC § 112

2. Claims 1, 17, 18, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, it is not clear how the efficient frontier is used to approve an application for a financial product. The claim recites the calculation of an efficient frontier using a first and second investment option. The financial product is not used in the efficient frontier calculation, but the claim recites that the efficient frontier is calculated "for said financial product", implying that the efficient frontier is specific to the financial product. However, the financial product does not appear to be involved in the efficient frontier calculation. Furthermore, since there are a virtually limitless number of ways one could use an efficient frontier curve to approve a loan, without further recitation of how the efficient frontier is used in the context of a loan application, the claim is considered indefinite. For the purposes of

applying prior art, Examiner will interpret the determining step to include comparing the disk/reward of the loan to the risk/reward defined by the efficient frontier.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-3, 5-8, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goetzmann's website "An Introduction to Investment Theory" as it existed on December 6, 1998, hereinafter *Goetzmann*, in view of Applicant's admitted prior art, and further in view of Gold's article "Senior Secured Floating-Rate Bank Loans for Life Insurance Company Investment Portfolios," hereinafter *Gold*.

Claims 1, 5, 6, 17, Goetzmann discloses matching a level of risk to an expected return, comprising selecting a first and a second investment option (figure 2), wherein the first investment option is a zero risk investment (U.S. T-bill), and the second investment is a higher risk option than the first investment option, and has a calculable return on investment for a calculable risk (U.S. Small Stock TR), wherein each investment option has a calculated return on investment, and a calculated risk based on its duration, and calculating an efficient frontier between the first and second investment options defining a plurality of risks and corresponding returns on investment (pages 6 and 7).

Goetzmann fails to teach determining whether to approve an application for a financial product based on the efficient frontier, wherein the financial product is a loan. According to Applicant's admitted prior art in Applicant's specification, approving applications for loans for automobiles according to a risk/reward schedule was known in the art at the time of Applicant's invention (page 2, lines 13-19). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Goetzmann to include approving an application for a loan based on an efficient frontier risk/reward schedule because Gold teaches mixing bank loans with fixed income assets in an attempt to yield the most efficient portfolio as it relates to risk and return, as is defined by an efficient frontier (see especially pages 51, 52).

Claim 2, 3, Goetzmann teaches zero risk investments (riskless assets), as discussed above, and such investments inherently have a borrowing rate.

Claims 7, 17, Goetzmann, Applicant's specification, and Gold fail to teach the steps of calculating a return on investment. As cited in the previous office action, return on investment is old and well known in the art as being net income divided by capital invested (Examiner respectfully notes that while the claim language repeatedly calls for "annualized net *income*," Examiner believes this to be a typographical error, since the specification calls for an annualized net *investment*, and dividing a net income by an annualized net income would result in the number of years, not an ROI figure, as claimed). Furthermore, Examiner notes that Applicant's failure to challenge Examiner's statement of Official Notice is taken to be admitted prior art.

Claim 8, Goetzmann teaches the efficient frontier is identified by the slope of the line between the two investment options (figure 2).

6. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goetzmann's website "An Introduction to Investment Theory" as it existed on December 6, 1998, hereinafter *Goetzmann*, in view of Applicant's admitted prior art, and further in view of Gold's article "Senior Secured Floating-Rate Bank Loans for Life Insurance Company Investment Portfolios," hereinafter *Gold*, as applied above to claims 1 and 17, and further in view of Larache et al., U.S. Patent No. 5,765,144.

Goetzmann and Gold fail to teach a computer performing the methods disclosed therein.

Larache teaches a system for selecting liability products comprising a computer, communications device, and memory units, which processes financial calculations (column 4). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Goetzmann and Gold to include a computer as taught by Larache because it is desirable to implement calculations through a computer in order to improve efficiency.

Response to Arguments

7. Applicant's arguments with respect to claims 1 and 17-19 have been considered but are moot in view of the new grounds of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Kesack whose telephone number is (571)272-5882. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3691

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted,

Daniel Kesack
February 29, 2008
/D. K./
Examiner, Art Unit 3691

/Hani M. Kazimi/
Primary Examiner, Art Unit 3691